Remarks

Restriction

Applicant has carefully reviewed the office communication mailed September 28, 2005. In that office communication, the Examiner indicated that the application contained claims directed to two invention groups. The Examiner required the election of one invention group. The two invention groups identified by the Examiner are as follows:

I. Claims 1-37, drawn to an apparatus, classified in class 118, subclass 719.

II. Claims 38-46, drawn to a method, classified in class 427, subclass 569.

Confirming Applicants election, Applicant elects Group II (claims 38-46) with traverse, as indicated in a telephone conference between the Examiner and Jim Paige on September 7, 2005.

In the Specification

The Examiner objected to the language and format of the Abstract. The Examiner states that the language should be clear and concise and should not repeat information given in the title such as "The disclosure defined by this invention". The abstract has been amended to remove the phrase "The invention provides methods". Therefore Applicant respectfully request the Examiner withdraw the objection to the Abstract.

§103 Rejection

Claims 38-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Countrywood et al. (6,110,540).

The Federal Circuit has stated that when more than one reference or source of prior art is required in establishing the obviousness rejection, "it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification." *In re Lalu*, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984). The Examiner must also show why it "would appear" that the references would have been combined. *See In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d

1780, 1783 (Fed. Cir. 1984). The Examiner must make all of the showings detailed in this paragraph in order to make a *prima facie* case of obviousness. The discussion below details how this burden has not been met.

Claim 38 was rejected under 35 U.S.C. §103 as unpatentable over Countrywood (U.S. Patent No. 6,110,540). The Examiner states that one skilled in the art would realize that applicant's delivering a charge to the electrode reads on the recitation of the cited reference. It would have been obvious to one skilled in the art to apply a charge to the electrode because the reference teaches applying a voltage with the expectations of success. Claim 38 recites "establishing in the substrate coating region a ***first gaseous atmosphere*** comprising a precursor gas.....establishing in the electrode cleaning region a ***second gaseous atmosphere*** comprising a sputtering gas." Claim 38 clearly calls out for a first substrate coating region and a second electrode cleaning region. By contrast, the plasma apparatus and method disclosed by Countrywood, et al only discloses a substrate coating region and does not disclose, whatsoever, an electrode cleaning region as set forth in claim 38. Therefore claim 38 is felt to distinguish patentability from Countrywood.

Moreover, the structure that would result from the Examiner's proposed combination does not mean the terms of claim 38. Such claim, once again, recites "establishing in ***the substrate coating region*** a first gaseous atmosphere comprising a precursor gas....establishing in ***the electrode cleaning region*** a second gaseous atmosphere comprising a sputtering gas." By contrast, Countrywood merely discloses a single substrate coating region and not an ***electrode cleaning region***. Therefore, the combination that would result would still lack a substrate coating region and an electrode cleaning region as required by claim 38. Therefore, claim 38 is patentably distinct from Countrywood.

Claims 39-46 depend from allowable base claim 38, therefore claims 39-46 are also therefore felt patentably distinguishable from Countrywood.

In light of the above, applicant respectfully submits that claims 38-46 are in condition for allowance. As these are the only claims pending in the application, issuance of a Notice of Allowance is courteously solicited.

The application presents 1 independent claims and 9 total claims. Please treat any communication filed at any time in this application, requiring a petition for extension of time under 37 CFR 1.136(a) towards timely submission as incorporating a proper petition of an extension of appropriate length of time. If any additional fees are required to enter the present amendment, applicant hereby authorizes the office to charge our Deposit Account No. 06-1910.

If the Examiner feels prosecution of the present application can be materially advanced by telephonic interview the undersigned would welcome a call at the number listed below.

In view of the foregoing, reconsideration and allowance of this application are requested.

Respectfully submitted,

Dated: 12/27/05

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